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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,138	06/23/2003	Robert Lammle	3080-5578US	1579
24247	7590	05/21/2004	EXAMINER	
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			TRAIL, ALLYSON NEEL	
			ART UNIT	PAPER NUMBER
			2876	
DATE MAILED: 05/21/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/602,138

**Applicant(s)**

LAMMLE, ROBERT

**Examiner**

Allyson N Trail

**Art Unit**

2876

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/23/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### ***Drawings***

1. Figure 2 is objected to because the figure is too dark and is difficult to read. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

2. Claim 17 is objected to because of the following informalities:

Re claim 17, line 2: replace "said display means" with --a display means.--

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 9, and 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Uecker et al (6,240,394).

Uecker et al teaches the following in regards to claims 1, 21, and 22:

"This invention relates generally to point-of-sale systems for use in pharmacies and, more specifically, to systems for automatically generating advisory and other information for distribution to pharmacy patients." (Col. 1, lines 7-10).

“Prescription drugs in the United States are uniquely identifiable by a National Drug Code (NDC), which is typically entered into a computer terminal by a pharmacist, and may be encoded on the product itself in bar-code form. Other prescription drug identification systems are employed in other countries, but the principle is the same: to provide a unique code for each prescription drug dispensed by the pharmacy. Based on the nature of the drug, a computer at the point of sale may be used to generate advisory messages to the patient, some of which may be required by governmental regulation, or to generate promotional materials concerning related or complementary products sold in the pharmacy.” (Col. 1, lines 13-25).

Uecher et al teaches the following in regards to claim 9:

The method of electronically disclosing the pharmaceutical information is by printing the pharmaceutical information on a print medium. “The present invention resides in a method and apparatus for generating advisory and other information without major modification of an existing pharmacy computer system. Briefly, and in general terms, the method of the invention comprises the steps of capturing a data record pertaining to a pharmacy transaction as transmitted to a pharmacy printer; comparing selected components of the captured data record with corresponding components of a database to determine the contents of a message associated with particular values of the data components; building an output message based on the results of the comparing step; and transmitting the output message to a printer in the pharmacy, to print an advisory message that is appropriate for the particular values of the data components defining the transaction.” (Col. 1, lines 43-56).

Uecher et al additionally teaches the following in regards to claims 21 and 22:

When selecting an advisory message to be given to the patient, the patient's age, gender, and other data are inputted to the computer in order to give the appropriate advisory message.

"The selected data components include any combination of the identity of the dispensed product, the patient's age and gender, the identity of a party primarily responsible for payment to the pharmacy for the transaction and an indication of whether the transaction is based on a new or a refill prescription. Based on these factors, the advisory message can be tailored to the particular transaction." (Col. 1, lines 56-62).

Uecher et al teaches the following in regards to claim 23:

"Yet another advantage of the invention is that, if the health advisory computer 14 is connected to a network of similar computers, advisory messages can be directed to pharmacists over this network and printed on the pharmacy printer." (Col. 7, lines 23-27).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11 and 12-17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uecker et al (6,240,394).

Uecher et al teaches the following in regards to claims 11 and 14:

See Uecher et al's teachings in regards to claim 1. Additionally, Uecher et al teaches a retrieval means for retrieving stored pharmaceutical information.

"a database containing advisory message data in association with preselected combinations of components of transaction data; an additional processor, for comparing transaction data components monitored in each transaction with the preselected combinations of transaction data components in the database, wherein the advisory message data components associated with the monitored transaction data components are retrieved from the database; and wherein the additional processor also includes means for building an advisory message from the retrieved advisory message data components; and means for printing the advisory message for distribution to the patient whose transaction is being monitored." (Col. 2, lines 20-32).

Uecher et al teaches the following in regards to claim 12:

When selecting an advisory message to be given to the patient, the patient's age, gender, and other data are inputted to the computer in order to give the appropriate advisory message.

"The selected data components include any combination of the identity of the dispensed product, the patient's age and gender, the identity of a party primarily responsible for payment to the pharmacy for the transaction and an indication of whether the transaction is based on a new or a refill prescription. Based on these factors, the advisory message can be tailored to the particular transaction." (Col. 1, lines 56-62).

Uecher et al teaches the following in regards to claims 13:

As mentioned above the identification means consists of a bar code.

“Prescription drugs in the United States are uniquely identifiable by a National Drug Code (NDC), which is typically entered into a computer terminal by a pharmacist, and may be encoded on the product itself in bar-code form.” (Col. 1, lines 13-17).

Uecker et al’s teachings are discussed above. Uecker et al fails to specifically teach a barcode scanner. As discussed above however, the identification means included on the pharmaceutical product may comprise a barcode. It is additionally taught above, that the identification information is used to create an advisory message for the patient.

Uecher et al teaches the following in regards to claims 15:

See Uecher et al’s teachings regarding claim 9.

Uecher et al teaches the following in regards to claims 17:

See figure 1. The figure shows the computer-based apparatus, which controls the scanning means and has a display means.

Uecher et al teaches the following in regards to claim 19:

“Yet another advantage of the invention is that, if the health advisory computer 14 is connected to a network of similar computers, advisory messages can be directed to pharmacists over this network and printed on the pharmacy printer.” (Col. 7, lines 23-27).

In view of Uecker et al’s teachings above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a barcode scanner

for scanning the barcode, which is attached to the pharmaceutical product. Because Uecker et al teaches a barcode for identifying the product, it is therefore suggested by Uecker et al that a barcode scanner also be included.

7. Claims 2, 4-6, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uecker et al (6,240,394) in view of Catan (2002/0143860).

Uecker et al's teachings are discussed above. Uecker et al fails to teach prompting the user with a first message, wherein the message provides the user with an interactive choice of accepting or declining information about a scanned product.

Catan teaches the following in regards to claim 2:

"Referring to FIG. 16, yet another sequence begins with the acquisition of MRL device T data at S70. The data is stored at S72 on the reader 100/120. Then, when the reader 100/120 is connected, the reader 100/120 connects to the network server 140 and transmits the stored data at S74. At S76, the user is prompted to accept a message from the network server 140, and upon acceptance, the message is delivered at S78 concurrently or at a later time." (Pages 13 and 14, paragraph 0135).

Catan teaches the following in regards to claim 4:

Figure 1 shows the portable reader 100. The portable reader is an electronic input device.

Catan teaches the following in regards to claim 5:

Figure 1 further shows the electronic input device 100, comprising a keyboard.

Catan teaches the following in regards to claim 6:



“The identification of discriminants is a well-developed technology in itself. A very simple approach is to generate a histogram that indicates the terms that appear most often in the returned records and to allow the user to select from among the terms with the highest frequency.” (Page 16, paragraph 0153).

Catan teaches the following in regards to claim 10:

Figure 1 shows the portable reader 100. The portable reader includes a display where messages are shown.

In view of Catan's teachings it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Catan's method of prompting the user with a message in order to receive a command to disclose product information. Uecker et al's teachings above disclose a method for automatically generating advisory information for pharmacy patients. Both Catan and Uecker et al teach offering beneficial information to a user. Uecker et al offers the information automatically while Catan waits for a user command. Although Catan's invention does not specifically deal with pharmaceutical products, the invention is geared towards a label reader. One would be motivated to use Catan's method of waiting for a user command in order to avoid wasting the time of a user who is not in need of the product information.

8. Claims 7, 20, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uecker et al (6,240,394) in view of Stewart (2003/0183683).

Uecker et al's teachings are discussed above. Uecker et al fails to teach recording an electronic signature of the patient.

Stewart teaches the following in regards to claims 7, 20, and 24:

"A digital signature capture means or signature pad 510 generally well known to those skilled in the art is coupled to the computer means 504 and is used to capture the signature of the donor, collector, or other personnel as required in accordance with the specific established requirements specified by local, state, federal or other health in regulatory agencies."

In view of Stewart's teachings it would have been obvious to one of ordinary skill in the art at the time the invention was made to use Stewart's digital signature capturing device in combination with Uecker et al's teaching. One would be motivated to additionally include an electronic signature capturing device in order to authenticate the patient before administering the prescription.

9. Claims 7, 20, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uecker et al (6,240,394) in combination with Catan (2002/0143860) and in further view of Kaafarani et al (2004/0078237).

Uecker et al in combination with Catan's teachings are discussed above. The combination fails to allow the patient the interaction option of speaking to the pharmacist.

Kaafarani et al teaches the following in regards to claims 3 and 8:

"Still further embodiments provide the patient an optional step of dialing direct from the module to speak with a customer service representative or, if necessary, to speak with a pharmacist or pharmacy technician."

In view of Kaafarani et al's teachings it would have been obvious to one of ordinary skill in the art at the time the invention was made to give the patient the option

of speaking to the pharmacist. Although the automatic or commanded information is beneficial, the patient may additionally have questions for the pharmacist. One would be motivated to include the option of speaking to the pharmacist for the above reason.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Greenven et al (2004/0081669), Badinelli (2004/0078218), Drapeau et al (2004/0068421), Leonardi (2003/0112466), Boyer et al (6,202,923), Byerly et al (6,067,524), Bluth et al (6,692,436), Acosta (2004/0015395), Norris (2003/0191714), Sussman (2003/0018495), Wantulok et al (2004/0059624), Sun et al (2002/0022973), Swartz et al (2003/0132298), and Xu et al (2004/0065739).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Allyson N. Trail* whose telephone number is (571) 272-2406. The examiner can normally be reached between the hours of 7:30AM to 4:00PM Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571) 272-2398. The fax phone number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [[allyson.trail@uspto.gov](mailto:allyson.trail@uspto.gov)].

*All Internet e-mail communications will be made of record in the application file.*  
*PTO employees do not engage in Internet communications where there exists a*

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*possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

Allyson N. Trail  
Patent Examiner  
Art Unit 2876  
May 14, 2004

*Jared J. Fureman*  
**JARED J. FUREMAN**  
**PRIMARY EXAMINER**